IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Confirmation No.: 5248
Plourde Jr., et al.	Group Art Unit: 2621
Serial No.: 10/008,439	Examiner: Choi, Michael P.
Filed: December 6, 2001	Docket No.: 60374.0040US01/CPOL 968069

For: Dividing and Managing Time-Shift Buffering Into Program Specific Segments Based on Defined Durations

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submit the following remarks in support of a request for a pre-Appeal Brief Conference. Claims 1-50 are currently pending and subject to a final rejection per the final Office Action mailed on January 22, 2010. Of particular relevance to the present response, the final Office Action rejected independent claims 1 and 26 under 35 U.S.C. §102(e), respectively. That is, independent claims 1 and 26 have been rejected as allegedly anticipated by *Ellis* (U.S. Patent Publication No. 2002/0174430. The final Office Action rejected other claims using at least the aforementioned grounds for rejection and other grounds and art references, but for purposes of the present response, Applicant addresses the rejection to claims 1 and 26 for purposes of pointing out errors of law Applicant respectfully traverses the rejection, and respectfully submits that there exists clear cases of error, supported by the evidence in the record, in this rejection.

REMARKS

Independent claim 1

Claim 1 recites (with emphasis added):

1. A media content recording system in a subscriber network television system, comprising:
a memory for storing logic;
a storage device comprising a buffer space for continuously buffering media content instances, the buffer space comprising at any one instance of time plural media content instances corresponding to different video programs; and
a processor configured with the logic to represent each of the media content instances in the buffer space as a respective management file stored in the memory, the management file comprising a data structure that includes information identifying a corresponding media content instance of the media content instances, the information including media guide scheduled start and end times.

Independent Claim 26

Claim 26 recites (with emphasis added):

26. A media content recording method in a subscriber network television system, comprising the steps of:
buffering media content instances into a buffer space, the buffer space comprising at any one instance of time plural media content instances corresponding to different video programs; and
representing each of the buffered media content instances as a management file in a memory separate from the buffer space.

The final Office Action (pages 3 and 8) rejected the above-emphasized features based primarily on Figure 111 of *Ellis*. Applicants expressed on pages 19 and 21-22 of the response to non-final Office Action, filed October 2, 2009, that *Ellis* constitutes an improper anticipatory reference since Applicants' filing date is December 6, 2001, whereas *Ellis*' filing date supporting Figure 111 is afterwards (February 21, 2002). Further, as set forth on page 19, for instance, of Applicants' October 2nd response, no evidence has been presented by the Office of support of FIG. 111 by any of the electronically-viewable provisionals cited above. The Examiner has alleged on page 2 of the final Office Action the following in rebuttal:

> As per remarks on page 19, applicant argues that Ellis is an improper anticipatory reference since Ellis' filing date is subsequent to applicant's date. In response, Ellis, though such filing date is 2/21/02, such related US application data relies upon provisional applications dated 6/28/01, 6/7/01, 5/14/01, 4/18/01, 2/27/01, and 2/21/01 as parent application data which precedes applicant's date. Therefore, such prima facie rejection has been established.

Applicants respectfully submit that this rebuttal by the Examiner is an error in law. 35 U.S.C. 102(e) is as follows (emphasis added by underlining):

> (e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language

There has been no evidence presented to-date that the above-emphasized claim language in claims 1 and 26 is found or supported in the published Ellis application that post-dates the filing date of Applicant's present application. Indeed, the position of the Office appears to be that priority claims to one or more earlier provisionals are sufficient to establish a pre-dating of Applicants' claims. This position of the Office is an error in law, and not supported by Federal case law. For instance, by analogy, *In re Wertheim*, 646 F.2d 527, 537, 209 USPQ 554, 564 (C.C.P.A. 1981) has expressed, in the context of continuing applications, the following:

> [T]he phrase in Section 102(e), "on an application for patent," necessarily invokes Section 120 rights of priority for prior co-pending applications. If, for example, the PTO wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains Sections 120/112 support for the invention claimed in the reference patent…[O]nly an application disclosing the patentable invention before the addition of new matter, which disclosure is carried over into the patent, can be relied upon to give a reference disclosure the benefit of its filing date for the purpose of supporting a Section 102(e)/103 rejection.

Thus, it is clear that the effective filing date of subsequently filed continuation applications under Section 120 depends on the sufficiency of disclosure in the earlier-filed parent application. Applicants respectfully submit that by analogy, provisionals should also apply. Applicants are aware of utility application claims that have been denied the benefit of a prior filed, provisional (from which priority was claimed) for alleged insufficiency in disclosure to support the claims. If the *Ellis* utility was to claim the subject matter emphasized above for claims 1 and 26, assuming no support in the provisionals for the claimed subject matter, a proper examination of *Ellis* by the Office should deny the benefit of the provisional priority claims.

In addition, Applicants have reviewed the provisionals of Ellis, except for the 60/290,709 and 60/284,703 "figures" (which have been corrupted and are not presently viewable from PAIR) and respectfully submit that such reviewed provisionals fail to support Figure 111. Applicants have on multiple occasions requested that the Office provide this information, to no avail.

For at least these reasons, Applicant submits that there is an error in law, and that the rejection of claims 1 and 26 be withdrawn and prosecution re-opened.

CONCLUSION

Favorable reconsideration and allowance, or the re-opening of prosecution on the merits, of the present application is hereby courteously requested.

Respectfully submitted,

Date: May 24, 2010

/David Rodack/
David Rodack, Reg. No. 47,034

Merchant & Gould
P.O. Box 2903
Minneapolis, Minnesota 55402-9946
Telephone: 404.954.5049